

AF/3711

PATENT APPLICATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In application of

Shinichi OSHIMA

Appln. No.: 08/988,181

Group Art Unit: 3711

Confirmation No.: Not Assigned

Examiner: Raeann Gorden

Filed: December 10, 1997

For: GOLF BALL SELECTION DEVICE

REPLY BRIEF PURSUANT TO 37 C.F.R. §1.193(b)

Commissioner for Patents
Washington, D.C. 20231

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Sir:

Appellant respectfully submits this Reply Brief to respond to the Examiner's Answer of March 22, 2002.

In the "Response to Argument," the Examiner fails to cite any teaching or suggestion in the applied references, Connell or Taylor, where there is a "generally rectangular indication section formed on the package as explicitly required by the claims. For example, claim 12 requires "a generally rectangular indication section formed on said package for indicating a plurality of performance characteristics of the golf ball, said section including two or more sub-sections, each of said sub-sections comprising an icon and a first said of descriptive information to identify and specify a performance characteristic of the golf ball." Although Connell illustrates a label having various representations of pipes, there is no generally rectangular section having two or more sub-sections with each sub-section having an icon and a first set of descriptive information to identify and specify performance characteristic of a golf ball or even a

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pipe. At most, Connell has a plurality of pipes illustrated randomly across the entire label. Connell does not teach or suggest the structure of the package required by the claims on appeal. In this regard, Connell is deficient as a prior reference, and the combination of Connell and Taylor fails to teach or suggest this express requirement of the claims.

Secondly, the Examiner contends that Connell clearly provides a label in which the particular style or shape of a variety of styles of pipes and the name of the style of pipes packed in a given container may be accessible from a rapid inspection of the label. However, Connell clearly teaches that the label shows all of the pipes made by the manufacture, regardless of the type of pipe in the actual package. (See, column 2, line 10-15 and column 2, lines 20-26; see also Appellants Brief, pp. 6-7.) This is also evidenced by Figs. 1 and 2 of Connell where there are illustrated various pipes on the label.

The Examiner also contends that the indicia or printed matter does not provide a basis for patentability. While true, the Appellant is not attempting to protect the actual wording (i.e., printed matter) used in the preferred embodiment of the present invention. Rather, the claims cover the structural components of the package. For example, claim 12 requires a package having a box body, a cover and a generally rectangular indication section including two or more sub-sections. It is this specific format and structural layout that is required by the claims. Appellant is not claiming the precise wording of the preferred embodiments.

Next, while Connell makes reference to the use of colors to denote price, claim 30 is directed to having a first set of descriptive information and defines the icon as having a color-encoded identification mark. In the context of the claims, that is, claims 12, 23 and 30, the color-

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encoded identification mark pertains to the descriptive information within one of the sub-sections to identify and specify a performance characteristic of the golf ball. Price is not information that is deemed to identify and specify a performance characteristic of a golf ball, or even a pipe. Clearly, someone of skill in the art would recognize the difference between performance characteristic and price.

Concerning the secondary reference, Taylor, the Examiner states again that it pertains to golf balls with different playing characteristics and are usually sold in boxes having a cover. While true, there is no teaching or suggestion in Taylor as to the specific limitations of the claims here. Other than the fact that the Taylor is directed to a golf ball, it has no applicability to this invention.

Moreover, there is no teaching or suggestion in Connell and Taylor that would suggest to someone of skill in the art to combine the respective teachings. In the first instance, Connell is clearly directed to non-analogous art and there is no suggestion or reasons provided by the Examiner why someone in the design of golf ball technology and the packaging therefor would resort to labels used to the manufacture and selling of pipes. Secondly, even if Connell is art that can be applied in this situation, there is no objective reasoning provided why someone of skill in the pertinent art would seek to combine the respective teachings. It does not follow that providing several illustrations of pipes on a packages would lead to providing a generally rectangular indication section on a package expressly required by the claims. Connell teaches placing illustrations of pipes all over a label and randomly placed orientations, and Taylor does not teach or suggest anything relative to this. The combination thus does not render obvious the present invention.

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For all of the foregoing reasons, Appellant respectfully submits that claims 12-43 are patentable over the applied art, and respectfully requests that the Examiner's rejection of the claims be overturned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert M. Masters", written over a horizontal line.

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